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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): Bohannon 13-13-1-1

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on _____

Signature _____

Typed or printed name _____

Application Number	Filed
10/626,835	July 24, 2003

First Named Inventor: Bohannon et al.

Art Unit	Examiner
2161	P. Kim

Applicant requests review of the final rejection in the above-identified application No amendments are being filed with this request

This request is being filed with a notice of appeal

The review is requested for the reason(s) stated on the attached sheet(s)
Note: No more than five (5) pages may be provided

I am the

- [ ] applicant/inventor
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3 73(b) is enclosed (Form PTO/SB/96)
- [X] attorney or agent of record Registration number 36,597
- [ ] attorney or agent acting under 37 CFR 1 34 Registration number if acting under 37 CFR 1 34 _____

Kevin M. Mason
Signature

Kevin M. Mason
Typed or printed name

203-255-6560
Telephone number

December 18, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS **SEND TO: Mail Stop AF, Commissioner for Patents, P O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): Bohannon et al.
Case: 13-13-1-1
Serial No.: 10/626,835
Filing Date: July 24, 2003
Group: 2161
Examiner: P Kim

Title: Method and Apparatus for Composing XSL Transformations with XML Publishing Views

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MEMORANDUM IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The present invention and prior art have been summarized in Applicants' prior responses.

STATEMENT OF GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-19 and 21-32 are presently pending in the above-identified patent application Claims 9, 18, 19 and 32 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Claims 1, 10 and 24 were rejected under 35 U.S.C. §102(a) as being anticipated by Helgeson (United States Patent No. 6,643,652). In addition, claims 2 and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Helgeson in view of Chau et al. (United States Publication No. 2002/012393). Claims 3, 11 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Helgeson, in view of Jones (United States Publication No. 2004/010754) and further in view of O'Carroll (United States Patent No. 6,772,165). Claims 6, 15, 19 and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Helgeson, in view of Jones and further in view of O'Carroll, in further view of Bernstein et al. (United States Patent No. 6,826,568) and in further view of Mani et al. (United States Patent No. 6,654,734). Claims 8, 17, 23 and 31 were rejected under 35 U.S.C. §103(a)

being unpatentable over Helgeson, in view of Jones, O'Carroll, Bernstein et al. and Mani et al., in further view of Fernandez (United States Patent No. 6, 785,673). Claims 9, 18 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Helgeson in view of W3C ("XSL Transformation (XSLT), Version 1.0). Claims 4-5, 7, 12-14, 16, 21-22, 27-28 and 30-31 were indicated to be allowable if rewritten in independent form. Claims 19 and 21-22 would be allowable if amended to overcome the Section 112 rejection.

Arguments

Section 112 Rejection (*"Substantially Similar"*)

The Examiner rejected claims 9, 18, 19 and 32 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. With regard to claims 9, 18 and 32, the Examiner has asserted that the terms "substantially" and "similar" are relative terms that render the claims indefinite. Applicants respectfully traverse the rejection for at least the following reasons.

As noted in Applicants' prior response, M.P.E.P. §2173.05(b) states:

> When a term of degree is presented in a claim, first a determination is to be made as to whether the specification provides some standard for measuring that degree. If it does not, a determination is made as to whether one of ordinary skill in the art, in view of the prior art and the status of the art, would be nevertheless reasonably apprised of the scope of the invention. Even if the specification uses the same term of degree as in the claim, a rejection may be proper if the scope of the term is not understood when read in light of the specification. ***While, as a general proposition, broadening modifiers are standard tools in claim drafting in order to avoid reliance on the doctrine of equivalents in infringement actions***, when the scope of the claim is unclear a rejection under 35 U.S.C. 112, second paragraph, is proper. See In re Wiggins, 488 F. 2d 538, 541, 179 USPQ 421, 423 (CCPA 1973).
>
> When ***relative terms are used in claims wherein the improvement over the prior art rests entirely upon size or weight of an element in a combination of elements***, the adequacy of the disclosure of a standard is of greater criticality.

Further, subsection (D) of M.P.E.P. §2173.05(b) goes on to state:

> The term "substantially" is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It is a broad term. In re Nehrenberg, 280 F 2d 161, 126 USPQ

> 383 (CCPA 1960). The court held that the limitation "to substantially increase the efficiency of the compound as a copper extractant" was definite in view of the general guidelines contained in the specification. In re Mattison, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The court held that the limitation "which produces substantially equal E and H plane illumination patterns" was definite because one of ordinary skill in the art would know what was meant by "substantially equal." Andrew Corp. v. Gabriel Electronics, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988).

The Examiner did not address any of this MPEP guidance in the latest Office Action. The standard of interpretation thus looks first toward the specification. Applicants respectfully direct the Pre-Appeal board to the present specification at page 3, lines 12-15, for example, where it is noted that "when the modified view query is evaluated on a relational database instance, the *same* XML document is obtained as would be obtained by evaluating the XSLT stylesheet on the original XML view." See also, page 5, lines 18-20. The above passages are just some examples of parts of the specification that give definition to the phrase "substantially similar."

Thus, where (i) the broadening modifiers are employed to avoid reliance on the doctrine of equivalents in infringement actions, and (ii) the improvement over the prior art in no way rests upon the size or weight of an element in a combination of elements, **the use of such broadening modifier should not be found to be indefinite**. *Cf.* M.P.E.P. §2173.05(b)

The scope of claims 9, 18 and 32 would be interpreted by a person of ordinary skill in the art to cover situations where the obtained XML document is the *same as* a second XML document produced by applying said XSLT stylesheet on said XML document produced by said initial view query, *as well as any trivial differences* between the obtained XML document and the second XML document that are made to avoid literal infringement. Thus, the specification provides a clear and definite standard for measuring the degree intended to be covered by the phrase "substantially similar."

The above-cited M.P.E.P. section teaches that a determination is made as to whether one of ordinary skill in the art, in view of the prior art and the status of the art, would be nevertheless reasonably apprised of the scope of the invention. Applicants submit that, given the disclosure of the present specification, the prior art, and the status of the art, those ordinarily skilled in the relevant art would be reasonably apprised of the scope of the invention.

Independent Claims

Independent claims 1, 10 and 24 were rejected under 35 U.S.C. §102(a) as being anticipated by Helgeson. Regardingclaim 1, for example, the Examiner asserts that Helgeson teaches a method for exporting at least a portion of a relational database to an XML document. Helgeson is directed to methods and apparatus for managing data exchange among systems in a network.

With regards to claims 1 and 24, the Examiner asserts that column 80, lines 51-55, discloses an "initial view query" that defines an XML view on a relational database. The Examiner further asserts that columns 49 and 73-74 disclose "modifying the initial view query to account for an effect of said at least one transformation (specified in an XLST stylesheet)."

As discussed in the original Background section (Page 1, lines 27-31):

> XML-publishing middleware technology is rapidly being implemented by relational database vendors to ensure that XML-centric applications are well supported. Such middleware *provides a declarative view query language* with which to specify the desired mapping between the relational tables and the resulting XML document. Based on the mapping defined by the view query, a portion of the database can be exported as XML.

As clearly established by the above passage, the term "view query" was a well-known **term of art** in the field of XML-publishing middleware at the time the present application was filed. *A "view query" thus specifies a mapping between the relational tables and the resulting XML document.* As further evidence of the fact that the term "view query" is a well accepted term of art, the Examiner is referred to, for example, FIG. 3 and corresponding text of Fernandez, which was cited by the Examiner in the present Office Action.

Column 80, lines 51-55, of Helgeson merely discloses that an XML document can be created from a database. Helgeson merely uses the term "view" in the presentation sense. Helgeson does not use the term "view query," nor does Helgeson address using view queries to map between relational tables and a resulting XML document. In addition, since Helgeson is not even addressing "view queries," Helgeson does not disclose or suggest "modifying the initial view query to account for an effect of said at least one transformation (specified in an XLST stylesheet)," or "applying said modified view query to said relational database to obtain said XML document" (of claims 1 and 24).

In the Response to Arguments section, the Examiner asserts that the term "view query" may be interpreted as to include that as disclosed by Helgeson. *The Examiner is reminded that*

Helgeson merely uses the term "view" in the presentation sense, and Helgeson does ***not*** *use the term "view query" at all! In addition, Helgeson does* ***not*** *address using view queries to map between relational tables and a resulting XML document!* The Examiner has not provided ***any*** support for any contrary interpretation of the term of art "view query" in the field of XML-publishing. Again, a *"view query" specifies a mapping between the relational tables and the resulting XML document*. The term *"view query"* is clearly distinct from the term *"view."* A person of ordinary skill in the art would not apply the generic term "view" when the more specific term "view query" is meant.

Similarly, for claim 10, the Examiner again asserts the Helgeson discloses an XML view on a relational database to produce the modified view query. (col. 80, lines 51-55). The term "view query" is a well-known term of art in the field of XML-publishing middleware that specifies a mapping between the relational tables and the resulting XML document. Column 80, lines 51-55, of Helgeson merely discloses that an XML document can be created from a database. Helgeson merely uses the term "view" in the presentation sense. Helgeson does not use the term of art "view query," nor does Helgeson address "an XML view on a relational database to produce said modified view query."

Dependent Claims

Claims 2-9, 11-18, 20-23 and 25-32 are dependent on independent claims 1, 10, 19 and 24, respectively, and are therefore patentably distinguished over each of the cited references, alone or in combination, because of their dependency from independent claims 1, 10, 19 and 24, for the reasons set forth above, as well as other elements these claims add in combination to their base claim.

All of the pending claims following entry of the amendments, i.e., claims 1-19 and 21-32, are in condition for allowance and such favorable action is earnestly solicited. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

The Examiner's attention to this matter is appreciated.

Respectfully,

Kevin M. Mason

Date: December 18, 2006

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